

REMARKS

This communication responds to the Office Action mailed on June 14, 2006. No claims are amended, no claims are canceled, and no claims are added. Claims 13-37 have been withdrawn. As a result, claims 1-37 are now pending in this Application.

§102 Rejection of the Claims

Claims 8 and 9 were rejected under 35 USC § 102(e) as being anticipated by Misra et al. (U.S. 2005/0102240; hereinafter “Misra”). The Applicant does not admit that Misra is prior art and reserves the right to swear behind this reference at a later date. In addition, because a *prima facie* case of anticipation has not been properly established, the Applicant respectfully traverses this rejection of the claims.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. See *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

In the Office Action it is asserted that Misra teaches “allocating [a] master license (i.e. license pack).” However, a careful reading of Misra reveals that this assertion is incorrect – Misra describes a system that sends a “... ‘license pack’ containing a set of one or more individual software licenses” to a license server 28. See Misra, para. [0032]. The server, in turn, is “responsible for distributing the software licenses contained in the license pack to individual clients.” See Misra, para. [0034].

The assertion that Misra describes the existence of a master license in the form of a license pack is incorrect because a:

“...’master license’ ... may include any code, structure, or form of permission that permits an apparatus (i.e., a master device) to freely execute a selected application. ... That is, the master device granting permission to execute the application on the shareable device must also have a master license associated with the selected application.” *Application*, pg. 2, lines 10–18.

Misra’s never suggests or teaches that a license server has the ability to grant itself a license to execute the application. In fact, such operation is impossible, since Misra declares that after granting a license to a client, the:

“...license server 28 then digitally signs the software license using a signing key that is not disclosed to the client.” Misra, para. [0077].

If the license server were to grant a license to itself, then it could not sign the granted license “using a signing key that is not disclosed to the client” as taught by Misra.

Since Misra does not teach the identical invention claimed (i.e., “enabling execution of an application on a master device by allocating a master license and at least on shareable license to the master device”), claims 8 and 9 should be in condition for allowance. Reconsideration and withdrawal of the rejection of these under § 102 is therefore respectfully requested.

§103 Rejection of the Claims

Claims 1-7, 10, and 12 were rejected under 35 USC § 103(a) as being unpatentable over Misra in view of Lopatic (U.S. 2002/0138441; hereinafter “Lopatic”). Claim 11 was rejected under 35 USC § 103(a) as being unpatentable over Misra in view of Aldis et al. (U.S. 2004/0039916; hereinafter “Aldis”). First, the Applicant does not admit that Lopatic and Aldis are prior art, and reserves the right to swear behind these references in the future. Second, for the reasons described above, a *prima facie* case of obviousness has not been established as required by M.P.E.P. § 2142, and the Applicant respectfully traverses this rejection.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). The M.P.E.P. contains explicit direction to the Examiner in accordance with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which indicates that the motivation must be supported by evidence in the record.

No proper *prima facie* case of obviousness has been established because Misra, combined with the Examiner's suggested modification using Lopatic and/or Aldis, does not serve to teach all of the limitations set forth in the independent claims, namely enabling execution of an application "on a master device by allocating a master license". This conclusion applies as well to dependent claims 2-7 and 9-12, since any claim depending from a nonobvious independent claim is also nonobvious under 35 USC § 103. *See M.P.E.P.* § 2143.03. It is therefore respectfully requested that the rejection of claims 1-7 and 10-12 under 35 U.S.C. § 103 be reconsidered and withdrawn.

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

KRYSTOF C ZMUDZINSKI ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, Minnesota 55402
(210) 308-5677

By / Mark V. Muller /
Mark V. Muller
Reg. No. 37,509